



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,077	03/16/2000	Richard Adams Gillaspay	1590P/P196	2423
29141	7590	09/28/2004	EXAMINER	
SAWYER LAW GROUP LLP P O BOX 51418 PALO ALTO, CA 94303			ENG, DAVID Y	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/527,077	Applicant(s) GILLASPY ET AL.	
	Examiner DAVID Y. ENG	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 36-49 have been cancelled. The pending and active claims are 1-35.

Claims 2 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Steps d and e in claim 2 should be e and f. Further, step e of claim 2 is not understood.

Further with respect to claim 2, it is not seen how step e is related to the steps of parent claim 1. Note that the digital imaging device is purported to receive and not to send. Claim 9 has similar defect.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (USP 5,937,160) in view of Cheever (USP 6,275,882).

See at least Figures 1-2 and the description in lines 6-19 of column 4 in Davis. Davis teaches transmitting of e-mails between a server and a digital device via Internet. The e-mail contains an attachment. Davis also teaches examining the e-mail attachment for determining whether or not the attachment is of pre-determined type. Only the pre-determined types of attachment are accepted by the server for transmission.

With respect to claims 1, 8, 15, 16, 17, 23, 24 and 30, Davis teaches a method for allowing a portable digital imaging device to receive an attachment (line 9, column 4) associated with an email message (line 10 column 4), a first type of attachment (line 12

Art Unit: 2155

of column 4) being allowed by the portable digital imaging device, the attachment being described a second type, the method comprising :

(a) determining (see “only files of pre-determined type --- are accepted” in lines 11-13 of column 4 in Davis) whether the first type is the same as the second type prior to sending the attachment to the portable digital imaging device;

(b) providing the attachment to the portable digital imaging device if the first type is the same as the second type (the email of Davis along with the attachment are allowed to be sent to the receiver if the attachment is of the acceptable types, see lines 9-13 of column 4); and

(c) refusing (inherent, if the acceptable types are accepted, the not acceptable types are inherently refused) to provide the attachment to the portable digital imaging device if the first type is not the same as the second type;

(d) establishing communication (inherent, communication must be established for sending emails) to the portable imaging device prior to the determining step (a),

wherein the determining step (a) is performed after communication is established with the portable digital imaging device in step (d).

Davis did not teach that the digital device could be an imaging device. Digital camera capable of transmitting images via Internet is well known in the art as shown by Cheever in lines 58-62 of column 4. It would have been obvious to a person of ordinary skill in the art to use the system of Davis for transmitting the images of Cheever if it is desired to email to a digital imaging device.

With respect to claims 2 and 9, both the email message and the attachment are received from a sender in Davis.

With respect to claims 3-5, 10-12, 20-22, 28-29 and 33-35, fields containing attributes within a header is well known in the art. See Figure 3A in Davis. It would have been obvious to a person of ordinary skill in the art to include file types within the header so that attributes can be determined.

With respect to claims 7 and 14, see digital camera in lines 58-63 of column 4 in Cheever.

With respect to claims 18 and 31, it is inherent that an email is generated by a digital device user.

With respect to claims 19, 26 and 32, it is well known that the header of an email is part of the email.

With respect to claim 25, user interface is inherent in a digital device.

Claims 6 and 13 are allowed.

Applicants admitted, in the communication filed on 12/9/2003, that the server of Davis can accept certain attachments and not others. Applicants contended that Davis fails to teach refusing to send attachments based on the types of attachments allowed by the recipient. The Examiner disagrees. If the non-allowable types are refused to be accepted by the server, no non-allowable types can be sent by the server because the server does not have any.

Any inquiry concerning this communication should be directed to DAVID Y. ENG at telephone number 703-305-9691.


DAVID Y. ENG
PRIMARY EXAMINER